



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/035,305	11/09/2001	Ruth Lipman	LIPM-3298	1972

5409 7590 10/21/2002

ARLEN L. OLSEN
SCHMEISER, OLSEN & WATTS
3 LEAR JET LANE
SUITE 201
LATHAM, NY 12110

EXAMINER

COE, SUSAN D

ART UNIT	PAPER NUMBER
----------	--------------

1654

DATE MAILED: 10/21/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

FILE COPY

Office Action Summary	Application No.	Applicant(s)	
	10/035,305	LIPMAN, RUTH	
	Examiner	Art Unit	
	Susan Coe	1654	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 October 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 5 and 13-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 6-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2 & 3. 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-20 are currently pending.

Election/Restrictions

2. Applicant's election with traverse of Group I, claims 1-12, onion for species A, and lecithin for species B in Paper No. 5, dated October 8, 2002 is acknowledged. The traversal is on the ground(s) that the claims are not properly restrictable because a search of one group would encompass a search of the other groups. This is not found persuasive because while the search of all of the groups might overlap to a certain degree, they would not necessarily be coextensive.

The requirement is still deemed proper and is therefore made FINAL.

3. Claims 5 and 13-20 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected inventions and species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 5.
4. Claims 1-4 and 6-12 are examined on the merits.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-4 and 6-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Art Unit: 1654

Claim 1 provides for the use of an Allium extract, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 1 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

It seems that applicant's invention is directed towards using these extracts to repel animals; therefore, it is assumed that applicant means to claim a method of using an Allium extract to repel animals. Thus, in the interest of compact prosecution, this is what is examined.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined

was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 1, 2, 4, 6, 8, 9, and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Japanese Pat. Appl. No. 1-139515 A.

Applicant's claims are directed towards a method of using an onion extract by applying the extract to a substrate.

JP '515 teaches a method of using an onion extract to repel animals from garbage (see English abstract). The reference does not specifically teach that the onion extract contains allinase or the flavor precursors; however, these ingredients would naturally be found in onion.

7. Claims 1, 2, 4, 6, 8, 9, and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Japanese Pat. Appl. No. 8-239305 A.

JP '305 teaches a method of using an onion extract to repel animals (see English abstract). The reference does not specifically teach that the onion extract contains allinase or the flavor precursors; however, these ingredients would naturally be found in onion.

8. Claims 1, 2, 4, 6, 8, 9, and 10 are rejected under 35 U.S.C. 102(e) as being anticipated by US Pat. No. 6,244,518 B1.

US '518 teaches a method of using an onion extract to repel animals (see claims). The reference does not specifically teach that the onion extract contains allinase or the flavor precursors; however, these ingredients would naturally be found in onion.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-4 and 6-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 5,417,973 in view of US Pat. No. 4,965,070.

US '973 teaches a method of repelling animals using an onion extract. The repellant can also contain a preservative salt (see claims and column 2, first full paragraph). US '973 does not specifically teach applying the repellant to the same substrates that are claimed by applicant. However, a person of ordinary skill in the art would recognize that the repellant composition taught by US '973 could be used to repel animals from any surface that is known to be at risk for animal damage. Therefore, an artisan of ordinary skill in the art would be motivated to use the repellant of US '973 on the surfaces claimed by applicant.

US '973 also does not teach that the variety of onion used is the same as the claimed varieties. However, all of these varieties of onion are known. Therefore, any of these varieties could be used as the source of the onion used in the repellant of US '973.

US '973 also does not teach adding egg to their repellant. US '070 teaches that egg is an animal repellant (see column 2, last paragraph). Therefore, a person of ordinary skill in the art would reasonably expect that the addition of egg to the repellant of US '973 would be beneficial. Therefore, an artisan of ordinary skill would have been motivated to add egg to the repellant of US '973 based on the teaching of US '070. Lecithin would naturally be present in eggs.

Art Unit: 1654

10. Claims 1-3, 7, 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Pat. Appl. No. 1-139515 A in view of US Pat. No. 4,965,070.

As discussed above, JP '515 teaches a method of repelling animals using onion. However, JP '515 does not teach that the variety of onion used is the same as the claimed varieties. However, all of these varieties of onion are known. Therefore, any of these varieties could be used as the source of the onion used in the repellant of JP '515.

JP '515 also does not specifically teach adding a preservative to the repellant. It is known in the art to use preservatives in repellant composition. Therefore, a person of ordinary skill in the art would be motivated to add a preservative to the repellant of JP '515.

JP '515 also does not teach adding egg to their repellant. US '070 teaches that egg is an animal repellant (see column 2, last paragraph). Therefore, a person of ordinary skill in the art would reasonably expect that the addition of egg to the repellant of JP '515 would be beneficial. Therefore, an artisan of ordinary skill would have been motivated to add egg to the repellant of JP '515 based on the teaching of US '070. Lecithin would naturally be present in eggs.

11. Claims 1-3, 7, 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Pat. Appl. No. 8-239305 A in view of US Pat. No. 4,965,070.

As discussed above, JP '305 teaches a method of repelling animals using onion. However, JP '305 does not teach that the variety of onion used is the same as the claimed varieties. However, all of these varieties of onion are known. Therefore, any of these varieties could be used as the source of the onion used in the repellant of JP '305.

JP '305 also does not specifically teach adding a preservative to the repellant. It is known in the art to use preservatives in repellant composition. Therefore, a person of ordinary skill in the art would be motivated to add a preservative to the repellant of JP '305.

JP '305 also does not teach adding egg to their repellant. US '070 teaches that egg is an animal repellant (see column 2, last paragraph). Therefore, a person of ordinary skill in the art would reasonably expect that the addition of egg to the repellant of JP '305 would be beneficial. Therefore, an artisan of ordinary skill would have been motivated to add egg to the repellant of JP '305 based on the teaching of US '070. Lecithin would naturally be present in eggs.

12. Claims 1-3, 7, 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 6,244,518 B1 in view of US Pat. No. 4,965,070.

As discussed above, US '518 teaches a method of repelling animals using onion. However, US '518 does not teach that the variety of onion used is the same as the claimed varieties. However, all of these varieties of onion are known. Therefore, any of these varieties could be used as the source of the onion used in the repellant of US '518.

US '518 also does not specifically teach adding a preservative to the repellant. It is known in the art to use preservatives in repellant composition. Therefore, a person of ordinary skill in the art would be motivated to add a preservative to the repellant of US '518.

US '518 also does not teach adding egg to their repellant. US '070 teaches that egg is an animal repellant (see column 2, last paragraph). Therefore, a person of ordinary skill in the art would reasonably expect that the addition of egg to the repellant of US '518 would be beneficial. Therefore, an artisan of ordinary skill would have been motivated to add egg to the repellant of US '518 based on the teaching of US '070. Lecithin would naturally be present in eggs.

Art Unit: 1654


13. No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Coe whose telephone number is (703) 306-5823. The examiner can normally be reached on Monday to Thursday from 8:00 to 5:30 and on alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda Brumback, can be reached on (703) 306-3220. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Susan Coe, Examiner
October 17, 2002



LEON B. LANKFORD, JR.
PRIMARY EXAMINER